

Patent
Attorney Docket: LYNN/0083

REMARKS

Claims 1-3, 6-8, 16, 29-30, 33, 35, 37, 40-42 stand rejected under 35 U.S.C. 102(b) as being anticipated by the Soviet patent abstract SU 1604863. Claims 1-3, 6-8, 14, 16-18, 26, 29-30, 33-35, 37, 40-42 stand rejected under 35 U.S.C. 102(b) as being anticipated by Soviet Patent SU 1567655. Claims 1-3, 6-8, 14-17, 19-22, 24, 26-35, 37, 40-42 stand rejected under 35 U.S.C. 102(b) as being anticipated by Bouzek, *et al.* While the cited Soviet patent abstracts and Bouzek disclose limitations for the production of ferrates using electrochemical methods, none of these cited reference disclose the limitation claimed by Applicant of an aqueous hydroxide comprising "a mixture of at least two hydroxides," a limitation of Applicant's amended independent claims 1 and 30.

As taught in the MPEP, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. (MPEP § 2131).

Since none of the cited references for each of the three rejections under 35 U.S.C. 102(b) includes Applicant's claimed limitation of "a mixture of at least two hydroxides," Applicant respectfully asserts that a *prima facie* case of anticipation is not presented against independent claims 1 and 30 for each of the three § 102(b) rejections. Applicant respectfully requests reconsideration and withdrawal of the three § 102(b) rejections concerning independent claims 1 and 30, as amended, and further, of the rejections of all dependent claims depending therefrom. Please note that Applicant has cancelled claims 41 and 42.

Claims 1-8, 16-35, 37-38, 40-42 stand rejected under 35 U.S.C. 102(a) as being anticipated by International Publication Number WO 01/21856 of Chemergy Ltd., published March 29, 2001. Claims 9-15, 36 and 39 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Chemergy as applied to the claims above, and further in view of Bouzek, applied as above.

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Applicant filed the pending patent application on February 27, 2002, less than one year before the publication of Chemergy on March 29, 2001.

37 CFR 1.131 states in pertinent part:

(a) When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based....Prior invention may not be established under this section in any country other than the United States, a NAFTA country, or a WTO country....

(b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference..... Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence satisfactorily explained.

Attached is a declaration of each of the Applicant inventors, pursuant to 37 CFR 1.131, showing that Applicant reduced the claimed invention to practice prior to the effective date of the cited Chemergy publication, which was published on March 29, 2001. The attached declaration provides, with supporting evidence, that Applicant invented and reduced to practice an electrochemical cell for the production of ferrates having a hydroxide solution in fluid communication with an iron-containing anode and a cathode and that the hydroxide was a combination of NaOH and KOH. The declaration also provides that such reduction to practice occurred in the United States before March 29, 2001.

Therefore, because Applicant has shown that the claimed invention was conceived and reduced to practice prior to Chemergy's publication date of March 29, 2001, Applicant respectfully requests reconsideration and withdrawal of all claim rejections made under § 102(a) and § 103 that used Chemergy as a prior art reference. Please note that Applicant has cancelled claims 41 and 42.

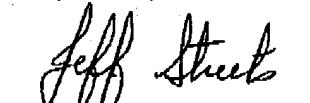
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Having addressed all claim rejections made in the Office Action dated March 24, 2004, Applicant respectfully asserts that all claims are now in condition for allowance and requests that a Notice of Allowance be issued. If the Examiner believes that a telephone interview would expedite the examination of this pending application, the Examiner is invited to call the undersigned attorney at the convenience of the Examiner.

In the event there are additional charges in connection with the filing of this Response, including late filing fees, the Commissioner is hereby authorized to charge the Deposit Account No. 50-0714/LYNN/0083 of the firm of the below-signed attorney in the amount of any necessary fee.

Respectfully submitted,



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